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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,695	07/23/2001	Reto Schoeb	015258-053700US	6977 9

20350 7590 06/26/2003
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EXAMINER

SORKIN, DAVID L

ART UNIT PAPER NUMBER

1723

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/912,695	SCHOEB, RETO	
	Examiner	Art Unit	
	David L. Sorkin	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 April 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 4-14 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-6 and 8-14 is/are rejected.
- 7) Claim(s) 7 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 April 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The substitute sheets of drawings, filed on 15 April 2003 have been approved.

Specification

2. Although the substitute specification filed 15 April 2003 has been entered, it is objected to. All sectional lines must be consistent with the substitute sheets of drawings. The sectional line numbering has been changed throughout the drawings, but not the specification.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:
5. Claim 10 is indefinite due to the construction of the preamble of the claim. The claim first recites "An agitating device comprising a magnetic stirring apparatus having a permanent magnet and a float body" and then recites "with a magnetic stirring apparatus according to claim 1". Subsequent references to "the magnetic stirring apparatus" are ambiguous as to which of the two recited stirring apparatus are being referenced. Furthermore, the magnetic stirring apparatus of claim 1 also requires a permanent magnet and a float body. The double recitation of elements should be

Art Unit: 1723

eliminate from claim 10, unless applicant actually intends to require two sets of elements.

6. Claims 11-13 are indefinite because they depend from canceled claim 2. If applicant amends these claims to depend from claim 10, applicant should assure that there is proper antecedent basis for "the permanent magnets of the magnetic stirring apparatus" recited in each of claims 11-13, as claim 10 only requires one such magnet.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 5, 6, 8-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipate by FR 2,449,473. Regarding claim 1, FR ('473) discloses a magnetic stirring apparatus comprising an agitator (17); at least one permanent magnet (3); a float body (11); and a bar (1) having an upper end, a lower end, an upper end section and a lower end section; the bar being tapered into a tip (12) at the lower end (see Fig. 2), the agitator being arranged at the lower end section of the bar (see Fig. 2); the float being arranged at the upper end section (see Fig. 1); and the at least one permanent magnet being connected to the agitator (see Figs. 1 and 2; page 1, lines 16 and 17). Regarding claim 5, the float body has an increasing inner cross-section at least along one part section in the direction of the upper end section (see Fig. 6). Regarding claim 6, at least one vane (14) is arranged at the bar. Regarding claim 8, the float body is formed in an

Art Unit: 1723

annular shape (see Fig. 7). Regarding claim 9, the agitator is bar shape (see Fig. 2). Regarding claim 10, ('473) discloses a agitating device comprising a magnetic stirring apparatus having a permanent magnet (3) and a float body (11) in accordance with claim 1 discussed above and further comprising a magnetic drive apparatus (including 6), said magnetic drive apparatus and said at least one permanent magnet (3) of the magnetic stirring apparatus forming a magnetic coupling (see Fig. 1; page 2, lines 1-3). Regarding claim 14, the stirring apparatus has a toe bearing (12).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2,449,473. Regarding claim 4, the apparatus of FR ('473) was discussed above regarding claim 1. While the agitator is formed symmetrically, as seen in Fig. 2, only a single magnet rather than two is disclosed. However, it has been held in *In re Harza*, 124 USPQ 378 (CCPA 1960) that such a duplication of parts is obvious within the meaning of section 103. It is quite unclear what is being claimed in claims 11 and 13 as discussed above regarding section 112; however, supposing claim 11 depended from claim 10 (which was discussed above), the difference between claims 11 and 13 and FR ('473) only being the duplication of magnets, which would not be considered a patentable distinction as held in *In re Harza, supra*.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over FR ('473) in view of de Bruyne (US 4,498,785). It is quite unclear what is being claimed in claims 12 as discussed above regarding section 112; however, supposing claim 12 depended from claim 10 (which was discussed above), the difference between claim 12 and FR ('473) being the duplication of magnets, which would not be considered a patentable distinction as held in *In re Harza, supra.*, and the use of an electromagnetic drive rather than a permanent magnet drive. De Bruyne ('785) is relied upon for teach that an electromagnetic drive is an art-recognized alternative to a permanent magnet drive in magnetic stirring apparatuses. See col. 4, lines 22-34 and col. 6, lines 55-66; Figs. 1 and 8.

Allowable Subject Matter

12. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art is FR 2449 473; however, this references does not disclose a permanent magnet the float body. While other references teach magnets being in float bodies (see EP 0 124 970 A2, JP 58-119329 A, US 4,759,635 and US 4,498,785), the combination of a permanent magnet in a float body arranged at an upper end section of a bar having a lower end tapering to a tip with another permanent magnet connected to an agitator that is at a lower end section of the bar is not disclosed or rendered obvious by the prior art.

Response to Arguments

13. Applicant states regarding the substitute specification, "all references in the specification which relate to the deleted section lines in accordance with 37 CFR 1.84(h)(3) have been removed". However none of these has been removed.
14. Applicant states "Claims 11 and 12 have been objected to, the Examiner noting that the reference character "10" should be replaced by - - 2 - -. The correction has been made." Although applicant deleted reference character "10" to alleviate the grounds for objection, applicant also changed "claim 10" to - -claim 2 - -; while simultaneously canceling claim 2.
15. Applicant's arguments regarding the prior art are moot due to the new grounds for rejection.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



David Sorkin

June 25, 2003



CHARLES E. COOLEY
PRIMARY EXAMINER